REMARKS/ARGUMENTS

Claims 1-6 are pending in the application. Claims 1, 2 and 4 have been amended. Claims 7 to 11 have been cancelled in this or a prior amendment without disclaimer or prejudice. No new matter has been introduced by the instant claims. Applicants reserve the right to pursue the subject matter cancelled in this or a subsequent application.

I. Rejection of claims 1-3, 5 and 6 under 35 U.S.C. § 112, first paragraph

Claims 1-3, 5 and 6 stand rejected under §112, first paragraph, as failing to comply with the written description requirement.

The rejection is traversed in part.

Claims 1 and 2 have been amended to delete the use of "optionally substituted" language from variables R1, R2, R5 and R6. In addition, the list of substituents for R3, R4 and R8 have been amended to more accurately reflect the species prepared and disclosed in the specification. Furthermore, as noted in the amendment submitted May 3, 2010, the use of optionally substituted language for variables R3, R4 and R8 in claims 1 and 2 is tempered by the inclusion of a definition of the optional substituents which may be present for each of these positions.

Thus, the claims as currently amended satisfy the written description requirement of §112, first paragraph.

II. Rejection of claims 1-6 under 35 U.S.C. § 103

Claims 1-6 stand rejected under §103 as being unpatentable over U.S. Patent 6,855,714 (Blume) in view of G. Patani & E. LaVoie *Bioisosterism: A rational Approach in Drug Design,* 96 Chem. Rev. 3147 (1996) (Patani).

As the Blume patent is understood, a genus of benzimdazoles are disclosed, which compounds are trisubstituted at the 1, 2, and either 5 or 6 position of the benzimidazole ring system. The disclosed compounds are allegedly efficacious in preventing diseases associated with microglia activation (e.g., Alzheimer's Disease, and related neurodegenerative diseases).

As noted by the Examiner, Blume discloses 113 species at columns 19 to 24. Each of these species is mono-substituted on the benzo ring of the benzimidazole ring system. More particularly, each of the disclosed compounds is mono substituted at the 5 or 6 position of the benzimidazole ring system. None of the compounds disclosed by Blume are substituted on the benzene ring ortho to the fused imidazole ring, e.g., at the positions corresponding to R3 and R6 of the formula I of claim 1 of the instant application.

In contrast, the instant application is directed to benzimidazole compounds which promote the release of parathyroid hormone. These compounds are suitable for use in methods of preventing or treating conditions of bone which are associated with increased calcium depletion or resorption or in which stimulation of bone formation and calcium fixation in the bone is desirable.

Claim 1 and 2, as presently amended, are directed to compounds in which R3 and R6 are selected from Markush groups which do not include hydrogen. Thus, the compounds provided by claims 1 and 2 are at least di-substituted on the benzo ring of the benzimidazole ring system.

The Office Action reliance of *in re Wilder* is improper in the instant application. The *Wilder* decision held that when "chemical compounds have 'very close' structural similarities and similar utilities, without more a *prima facie* case may be made."

Applicants note, that the instantly claimed compounds are promoters of parathyroid hormone release. In contrast, the Blume discloses that the compounds disclosed therein are inhibitors of microglia activation. Thus, there is no common utility between the compounds of Blume and the instant application.

Moreover, *In re Grabiak* (769 F.2d 729) tempers the availability of the *Wilder* analysis for other fact patterns. The court in *in re Grabiak* has stated that "the mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination."

The office action requires substantial contortions to obtain the compounds of the instantly claimed invention from the disclosure of Blume. In particular, the compounds of Blume must be positionally isomerized, multiple hydrogen atoms must be replaced with fluorine atoms and insertion of methylene group(s) are necessary to obtain the compounds of the invention. Nowhere does the Office Action assert any motivation to make the necessary changes nor is there any suggestion

from the cited art documents that such a particular combination of modifications would provide effective parathyroid hormone release promoters.

Claim 3 is directed to compounds of claim 1 in which R3 is selected from a limited number of substituents. As noted *supra*, Blume does not teach compounds having a non-hydrogen substituent at this position nor does Blume suggest that substitution at this position would provide any benefit. The Office Action has failed to provide any basis to make the necessary changes to the compounds disclosed in Blume to reach the particular species provided by claim 3.

Claim 4, as currently amended, is an independent claim directed to a plurality of benzimidazole species, each of which is mono- or di substituted on the benzene ring ortho to the fused imidazole ring. As noted *supra*, Blume does not teach compounds having a non-hydrogen substituent at this position nor does Blume suggest that substitution at this position would provide any benefit. The Office Action has failed to provide any basis to make the necessary changes to the compounds disclosed in Blume to reach the particular species provided by claim 4.

Absent of a showing of any motivation to make the multiple changes to the compounds disclosed in Blume, the Office Action has failed to establish a *prima facie* case of obviousness. Applicants request withdrawal of the rejection and reconsideration of the claims.

Should the Examiner have any questions, please contact the undersigned attorney.

Respectfully submitted,

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Date: December 3, 2010